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Quarles & Brady LLP TWO NORTH CENTRAL AVENUE One Renaissance Square PHOENIX, AZ 85004-2391			KAMAL, SHAHID	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAGDEEP SINGH SAHOTA, TRUDY HILL,
CAROLE OPPENLANDER, PATRICK SMETS, and
EDDY LODEWIJK HORTENSIA

Appeal 2009-005625
Application 10/628,702
Technology Center 3600

Decided: January 27, 2010

Before MURRIEL E. CRAWFORD, JOESPH A. FISCHETTI, and
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejections of claims 1-35. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We REVERSE.¹

THE INVENTION

Appellants' claimed invention relates to methods for performing transactions in wireless environments. The methods select an interface and the application which will be used in a point of sale transaction, and then informs the point of sale terminal of the appropriate data formats which will be used in the transaction. (Spec. ¶ [0001]).

Independent claim 1, which is deemed to be representative, reads as follows:

1. A method of performing a transaction comprising:
 - placing a first device in wireless communication with a second device;
 - selecting an application deployed on the first device which will be utilized to conduct the transaction, wherein the application selected is supported by the second device;
 - determining transaction processing capabilities supported by the second device;

¹ Our decision will make reference to the Appellants' Appeal Brief ("Br." filed Jun. 24, 2008) and the Examiner's Answer ("Ans.," mailed Sep. 4, 2008).

communicating application data from the first device to the second device, wherein the application data is selected in response to the transaction processing capabilities; and
processing the application data as required by the application to approve or disapprove the transaction.

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Weller et al.	US 2002/0111919 A1	Aug. 15, 2002
Lee	US 2002/0152178 A1	Oct. 17, 2002
Lapstun et al.	6,978,019 B1	Dec. 20, 2005

The Examiner rejected claims 1, 4-6, 10, 14, 15, 18, 19, 24, 27-29, and 33 under 35 U.S.C. § 102(e) as anticipated by Lee. Additionally, the Examiner rejected claims 2, 3, 7-9, 13, 16, 20-23, 25, 26, and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over Lee and Weller. Lastly, the Examiner rejected claims 11, 12, 17, 34, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Lee and Lapstun.

ARGUMENTS

The Examiner took the position that Lee discloses all of the limitations recited in independent claims 1 and 24. (Ans. 3-4).

Appellants argue *inter alia*, that Lee does not disclose the limitations of, selecting, determining, and communicating, as recited in claim 1. (Br. 5). Similarly, with regard to independent claim 24, Appellants argue *inter alia*, that Lee does not disclose the limitations of, transmitting, comparing, displaying, selecting, and communicating the desired application. (Br. 6).

Appellants additionally make arguments with respect to the dependent claims. (Br. 7-8).

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

1. Have Appellants shown the Examiner erred in finding that Lee discloses all the limitations of independent claims 1 and 24 under 35 U.S.C. § 102(e)?

2. Have Appellants shown reversible error in that Weller fails to cure the deficiencies of Lee under 35 U.S.C. § 103(a), as rejected in claims 2, 3, 7-9, 13, 16, 20-23, 25, 26, and 30-32?

3. Have Appellants shown reversible error in that Lapstun fails to cure the deficiencies of Lee under 35 U.S.C. § 103(a), as rejected in claims 11, 12, 17, 34, and 35?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by at least a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (explaining the general evidentiary standard for proceedings before the Office).

Lee

1. Lee is directed to a credit card transaction authentication system and method using a mobile terminal. (Abs.).
2. Lee describes a system which can provide credit card transactions by means of contactless radio-frequency identification with a mobile terminal. (¶ [0017]).

Weller

3. Weller is directed a payment authentication service which authenticates the identity of a payer during an online transactions. (Abs.).
4. Weller describes the use of an integrated circuit card as a means for authenticating a payer. (¶ [0009]).

Lapstun

5. Lapstun is directed to a method and system for user registration on a computer terminal. The registration is performed by a sensing device (i.e., electronic netpage pen) which compares data obtained from the sensing device to stored user registration data. (col. 2, ll. 15-33 and Fig. 8).

PRINCIPLES OF LAW

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

Claims 1, 4-6, 10, 14, 15, 18, 19, 24, 27-29, and 33 rejected under 35 U.S.C. § 102(e) as anticipated by Lee.

Independent claim 1

Appellants argue *inter alia* that Lee does not disclose the determining step, as recited in claim 1. (Br. 5). The Examiner did not specifically respond to this argument, but instead found in the Examiner’s Answer that Lee discloses, “determining credit card communication software supported by terminal 70[.]”² (Ans. 22). We cannot agree.

While we find that Lee describes a system which can perform credit card transactions by means of contactless radio-frequency identification with a mobile terminal (FF 2), we do not find within the disclosure of Lee a determining step which determines the processing capabilities supported by a second device, as recited in claim 1. We also do not find any basis for believing that such a determining step is performed inherently in Lee. Thus,

² The Examiner did not cite to the pertinent portions of Lee utilized to address Appellants’ limitation.

we agree with Appellants' argument that Lee fails to disclose at least the determining step as required by the method of claim 1.

Accordingly, we conclude that Appellants have shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(e) as being anticipated by Lee. As such, we find that the rejections of claims 4-6, 10, 14, 15, 18, and 19 which depend from claim 1 were also made in error for the same reasons discussed *supra*.

Claim 24

Appellants argue *inter alia* that Lee does not disclose the limitations of, transmitting, comparing, displaying, selecting, and communicating the desired application, as recited in claim 24. (Br. 6). To disclose these limitations the Examiner responded with respect to the limitation which recites "selecting" and found that Lee discloses, "selecting an [sic] credit card communication software deployed on the 'mobile terminal 60' which will utilize to conduct the transaction wherein the credit card communication software selected is supported by the 'terminal 70', processing the 'personal data, credit card number ST301' as required by credit card communication software to approve or disapprove the transaction[]." ³ (Ans. 19-20). We cannot agree.

Again, as discussed *supra*, Lee describes a system which can provide credit card transactions by means of contactless radio-frequency identification with a mobile terminal (FF 2). While Lee's system may be

³ The Examiner did not cite to the pertinent portions of Lee utilized to respond to Appellants' argument.

capable of performing a contactless credit card transaction (FF 1), we do not find within the disclosure of Lee a selecting step wherein a user selects a desired application from the mutually supported applications displayed on the second device, wherein such selection is performed by the user of the first device, as recited in claim 24. Thus, we agree with Appellants that Lee fails to disclose the limitations, transmitting, comparing, displaying, selecting, and communicating the desired application, as recited in claim 24.

Accordingly, we conclude that Appellants have shown that the Examiner erred in rejecting claim 24 under 35 U.S.C. § 102(e) as being anticipated by Lee. As such, we find that the rejections of claims 27-29 and 33 which depend from claim 24 were also made in error for the same reasons discussed *supra*.

ISSUE 2

Claims 2, 3, 7-9, 13, 16, 20-23, 25, 26, and 30-32 rejected under 35 U.S.C. § 103(a) as being obvious over Lee and Weller.

With regard to claims 2, 3, 7-9, 13, 16, 20-23, 25, 26, and 30-32, which depend from claims 1 and 24 respectively. As discussed *supra*, Appellants have shown that the Examiner erred in rejecting claims 1 and 24 under 35 U.S.C. § 102(e) as anticipated by Lee. The addition of Weller does not cure the deficiencies of Lee, and, as such, we find that the rejections of claims 2, 3, 7-9, 13, 16, 20-23, 25, 26, and 30-32, which depend from claims 1 and 24 respectively, were also made in error for the same reasons discussed *supra*.

ISSUE 3

Claims 11, 12, 17, 34, and 35 rejected under 35 U.S.C. § 103(a) as being obvious over Lee and Lapstun.

With regard to claims 11, 12, 17, 34, and 35, which depend from claims 1 and 24 respectively. As discussed *supra*, Appellants have shown that the Examiner erred in rejecting claims 1 and 24 under 35 U.S.C. § 102(e) as anticipated by Lee. The addition of Lapstun does not cure the deficiencies of Lee, and, as such, we find that the rejections of claims 11, 12, 17, 34, and 35, which depend from claims 1 and 24 respectively, were also made in error for the same reasons discussed *supra*.

CONCLUSIONS OF LAW

1. We conclude that Appellants have shown the Examiner erred in finding that Lee discloses all the limitations of independent claims 1 and 24 under 35 U.S.C. § 102(e).

2. We conclude that Appellants have shown reversible error in that Weller fails to cure the deficiencies of Lee under 35 U.S.C. § 103(a), as rejected in claims 2, 3, 7-9, 13, 16, 20-23, 25, 26, and 30-32.

3. We conclude that Appellants have shown reversible error in that Lapstun fails to cure the deficiencies of Lee under 35 U.S.C. § 103(a), as rejected in claims 11, 12, 17, 34, and 35.

DECISION

The decision of the Examiner to reject claims 1-35 is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2007).

REVERSED

ack

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